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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,353	12/08/2003	Yu-Chieh Lin	112.P77196	1352

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BERKELEY LAW & TECHNOLOGY GROUP, LLP
17933 NW Evergreen Parkway, Suite 250
BEAVERTON, OR 97006

EXAMINER
CHEN, CHIA WEI A

ART UNIT	PAPER NUMBER
2622	

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12/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/707,353	LIN, YU-CHIEH	
	Examiner	Art Unit	
	Chia-Wei A. Chen	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/20/2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of: .

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 9/20/2007 in application 10/707353.

The objections to the use of parentheses in claims 1, 6, and 19 are withdrawn in light of the amendments.

Response to Arguments

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claims 14-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-22 define a machine-readable medium encoded with a computer program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer–readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed machine-readable medium encoded with a

computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbahikari et al. (US 5,477,264) in view of Watkins (US 6,859,609).

Claim 1, Sarbadhikari teaches, in Fig. 11, a method comprising:

- providing an video capturing device (CCD 1a) configured to receive an external input and to create an video signal, wherein the video capturing device includes a non-removable memory (35); and
- storing an video processing program (24b) in the non-removable memory (35) of the video capturing device, wherein the video processing program is configured to be

transferred to a host computer and is further configured to be executed on the host computer (col. 11, lines 14-26, col. 8, lines 5-17).

Sarbadhikari does not teach an audiovisual signal.

Watkins teaches a recorder for recording audio and video signals (col. 4, lines 26-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the audio signal recording of Watkins with the method of Sarbadhikari in order to supplement a video signal, enabling an additional sensory dimension to the reproduction of a recorded scene.

Claim 10, Sarbadhikari in view of Watkins teaches an audiovisual device comprising:

- a processor (20 of Sarbadhikari) ; and
- a removable memory (camera memory) having stored thereon an audiovisual processing program capable of being executed by a host computer in response to connecting the audiovisual device to the host computer, wherein the audiovisual processing program is capable of improving the quality of an audiovisual signal captured by the audiovisual device, and wherein the removable memory is further capable of storing the audiovisual signal (image data 24a, col. 11, lines 14-26).

Claim 2, Sarbadhikari in view of Watkins teaches the method of claim 1, wherein the audiovisual capturing device is configured to transfer the audiovisual signal to the host computer, and wherein the audiovisual processing program is configured to process the audiovisual signal to improve the quality of the audiovisual signal if the audiovisual

processing program is executed on the host computer (col. 8, lines 41-44 of Sarbadhikari).

Claim 3, Sarbadhikari in view of Watkins teaches the method of claim 1, wherein the audiovisual signal includes an image signal (image data 24a; col. 11, lines 19-20 of Sarbadhikari).

Claim 4, Sarbadhikari in view of Watkins teaches the method of claim 1, further comprising copying the audiovisual processing program to a memory of the host computer via a connection (cable 38) of Sarbadhikari) between the audiovisual capturing device and the host computer (Fig. 11, col. 11, lines 14-26 or Sarbadhikari).

Claim 5, Sarbadhikari in view of Watkins teaches the method of claim 1, wherein the audiovisual processing program is capable of optimizing the audiovisual signals stored in the non-removable memory (The embodiment taught in col. 11, lines 14-26 of Sarbadhikari is able to perform the functions taught in col. 7, lines 51-67 of Sarbadhikari).

Claim 6, Sarbadhikari in view of Watkins teaches the method of claim 1, further comprising:

- copying the audiovisual processing program from the non-removable memory (computer memory) to a removable memory (camera memory); and

- transferring the audiovisual processing program from the audiovisual capturing device to the host computer via the removable memory, wherein the audiovisual processing program is configured to cause the host computer to execute the audiovisual processing program in response to the host computer receiving the audiovisual processing program (col. 11, lines 18-26).

Claims 7 and 11, Watkins teaches wherein the audiovisual device is comprises a digital camera (Fig. 2, col. 4, lines 54-56 of Watkins).

Claims 8 and 12, Watkins teaches wherein the audiovisual device is comprises a digital recorder (col. 4, lines 26-27 of Watkins).

Claim 9, Sarbadhikari in view of Watkins discloses substantially the claimed invention as set forth in the discussion for claim 9. Watkins does not disclose expressly wherein the audiovisual device is a digital pen.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to configure the audiovisual device to be a digital pen. Applicant has not disclosed that configuring the audiovisual device to be a digital pen provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the digital camera or camcorder taught by Watkins or the claimed digital pen because all devices perform the same function of recording a

audiovisual signal. Therefore, it would have been obvious to modify Watkins to obtain the invention as specified in claim 9.

Claim 13, Sarbadhikari in view of Watkins teaches the device of claim 10, wherein the removable memory comprises a read only memory (electrically erasable firmware memory 36, also known as EEPROM (Electrically Erasable Programmable Read Only Memory)).

Claims 14-22 are analyzed as a machine readable medium having stored thereon instructions that if executed, result in the method of claims 1-9.

Claims 23-31 are analyzed as an apparatus performing the method of claims 1-9.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chia-Wei A. Chen whose telephone number is 571-270-1707. The examiner can normally be reached on Monday - Friday, 7:30 - 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cac
12/7/07

NGOC-YEN VU
SUPERVISORY PATENT EXAMINER